## REMARKS

Claims 25 - 27 have been canceled by a prior amendment without prejudice or disclaimer of the subject matter thereof. Applicants reserve the right to pursue the subject matter of any of the canceled claims in the subject application and subsequently filed continuing applications.

Claims 1, 9 and 17 have been amended.

Claims 1 - 24 are present in the subject application.

In the Office Action of June 27, 2008, the Examiner has rejected claims 17 - 24 under 35 U.S.C. §101, and has rejected claims 1 - 24 under 35 U.S.C. §103(a). Favorable reconsideration of the subject application is respectfully requested in view of the following remarks.

The Examiner has rejected claims 17 - 24 under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Examiner takes the position that the claims do not specify that the claimed invention includes hardware and, thus, merely describe a computer program per se. Applicants respectfully traverse the rejection. However, in order to expedite prosecution of the subject application, independent claim 17 has been amended for further clarification and recites the feature of a computer system. Accordingly, independent claim 17 and its corresponding dependent claims are considered to comply with 35 U.S.C. §101.

Applicants gratefully acknowledge the courtesies extended by Examiner Bashore during the recent Interview of April 1, 2008. During the Interview, the Examiner indicated that further clarification of the content object and entities as virtual or digital objects may overcome the rejections, but further consideration would be needed.

In the prior amendment, independent claims 1, 9 and 17 had been amended to further clarify aspects of the claimed invention, and recited the features of: the content object being a digital object; the content entities each including content comprising digital data; and generating an estimated content count for the selected content entities from the digital data within those entities.

The Examiner has maintained rejections in response to that amendment. In particular, the Examiner has rejected claims 1 - 6, 9 - 14 and 17 - 22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,905,973 (Yonezawa et al.) in view of U.S. Patent No. 6,910,018 (Okada et al.) and further in view of U.S. Patent No. 5,768,521 (Dedrick).

Briefly, the present invention is directed toward a system, method and data storage device for creating a content object from a group of content entities. Each content entity is contained in a separate file object. A list or outline containing container and non-container identifiers defines the content, order and structure of the content object. This list or outline is stored as a separate file object. In addition, the present invention calculates the content object cost by estimating the amount of content it contains and determining a content cost based upon the content estimate. Optionally, a cost is assigned to each content entity in the data repository and these actual costs are summed as part of the cost estimation procedure.

In order to assist in an understanding of the present invention, the present invention features may be illustrated by the following example with respect to generation of a content object in the form of a book. The book structure may include volumes each with one or more chapters, where each chapter, in turn, may include one or more sections. The content of the

chapter sections resides in the data repository as individually accessible files each containing a section (or content entity). A user interface enables a user to manipulate, select and alter the book content. In other words, a user may construct and arrange the book (e.g., into volumes, chapters, sections, etc.) with content (e.g., text, images, etc.) selected from the data repository. In addition, the book's cost is calculated by estimating the amount of content it contains and determining a content cost based upon the content estimate. Optionally, a cost is assigned to each content entity in the data repository and these actual costs are summed as part of the cost estimation procedure.

The Examiner takes the position that the Yonezawa et al. patent discloses the claimed subject matter, except for the shopping basket being a collection of images, the price being determined from a content count and a digital object comprising digital data. The Examiner further alleges that the Okada et al. and Dedrick patents disclose these features, and that it would have been obvious to combine the Yonezawa et al., Okada et al. and Dedrick patents to attain the claimed invention.

This rejection is respectfully traversed. However, in order to expedite prosecution of the subject application, independent claims 1, 9 and 17 have been amended to further clarify the digital or virtual nature of the content object and content entities, and recite the features of: generating an estimated content count for the selected content entities that represents an estimated quantity of content within the content object, wherein the digital data within the selected content entities are utilized to determine the estimated content count representing the estimated quantity of content within the content object.

The cited documents do not disclose, teach or suggest these features. Rather, the Yonezawa et al. patent discloses an online shopping system having a shopping basket function capable of conducting an order process in onetime by storing items to be purchased in a purchase list. An interface for the shopping basket function is provided as a shopping basket window separate from a catalog window for displaying item data of the online shopping. The shopping basket function includes a list of items to be purchased, a function to add item data to the list and a function to change the item information registered in the list (e.g., See Abstract). Fig. 3 shows an example of a consumer screen including a catalog browser window with item data or item catalog expressed by character or image (e.g., See Column 4, lines 56 - 65 and Column 6, lines 45 - 48). Fig. 4 shows the shopping basket including various information pertaining to an item scheduled for purchase (e.g., item code, item name, unit price, quantity of items, sub-total and total payment) (e.g., See Column 5, lines 13 - 25).

Thus, the Yonezawa et al. patent discloses an online shopping system to purchase items, where images of the actual purchasable items are displayed to the consumers. There is no disclosure, teaching or suggestion of generating an estimated content count for selected content entities by utilizing the digital data of those entities and generating the price for the user to produce the user-defined content object with selected content entities in response to a first set of conditions; and generating the price for the user to produce the user-defined content object from the actual content counts of the selected content entities in response to a second set of conditions as recited in the independent claims. In fact, the Yonezawa et al. patent simply produces a price based on an ordered quantity and the unit price for the actual item (Fig. 4).

In addition, the Examiner interprets the shopping basket of the Yonezawa et al. patent as the content object. However, independent claims 1, 9 and 17 recite the features of generating a price for the user to produce the user-defined content object. Although the Yonezawa et al. patent discloses a price as discussed above, this price is for the purchase of the physical items placed in the shopping basket, and not for the construction of the shopping basket itself (or content object) as recited in the claims.

The Okada et al. patent does not compensate for the deficiencies of the Yonezawa et al. patent. Rather, the Okada et al. patent discloses a client-server environment in which a plurality of clients are connected on a network. A manager of a company: displays an approval request list window in which a list of purchase-requested articles is displayed, on a client by a predetermined operation; selects a desired article from the articles displayed in the window; and clicks a software button in accordance with approval or rejection of the selected article. At this time, the article for which approval is selected can be formally ordered (e.g., See Abstract).

The Examiner relies on a section of the Okada et al. patent describing a catalog search window in which an article may be requested from a catalog based on a keyword search or genre search (e.g., See Fig. 14; and Column 15, lines 3 - 21). Although the catalog data may include an estimated amount, this amount simply reflects an estimated purchase amount within the catalog data. The Examiner further relies on the requested quantity field in Fig. 17 of the Okada et al. patent. However, this field represents a purchase quantity of requested articles (e.g., See Column 16, lines 44 - 46) entered by a user.

Thus, the Okada et al. patent discloses a system enabling users to request and approve articles for purchase, where estimated prices and desired quantities of the articles are entered. There is no disclosure, teaching or suggestion of generating an estimated quantity of content for the content object based on the digital data in the individual digital entities selected for the content object, and generating a price based on the estimated quantity of content as recited in the independent claims. In other words, the estimated purchase prices and requested quantities of the Okada et al. patent relied upon by the Examiner are provided by the user and/or system (e.g., catalog data), whereas the independent claims recite generating a price for the content object based on an estimation of the quantity of content within the content object derived from the digital data of the individual content entities selected for the content object. In addition, there is no disclosure teaching or suggestion of selectively utilizing the estimated and actual content counts to generate a price for the content object as recited in the independent claims.

The Dedrick patent does not compensate for the deficiencies of the Yonezawa et al. and Okada et al. patents. Rather, the Dedrick patent discloses a computer network system that contains a metering mechanism which can meter the flow of electronic information to a client computer within a network (e.g., See Abstract; Column 1, lines 62 - 65; and Column 2, lines 43 - 64). The information can be generated by a publisher and electronically distributed. The publisher/advertiser is provided with tools to create electronic information transmitted over the system (e.g., See Abstract; Column 1, lines 65 - 66; and Column 4, lines 26 - 51). The client computers each contain a graphical user interface to request consumption of the information (e.g., See Abstract; Column 2, lines 2 - 4; and Column 3, lines 13 - 30). The metering

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mechanisms control the transfer of information to the client computers (e.g., See Abstract; Column 2, lines 4 - 6; and Column 3, lines 46 - 59). Each unit of information has an associated cost type and cost value that are used to calculate a price for the information (e.g., See Abstract; Column 2, lines 7 - 10; and Column 3, lines 60 - 63).

Thus, the Dedrick patent discloses a publisher creating information for access by an end-user and the price being calculated for the end-user to access or download that information based on a cost type and cost value. There is no disclosure, teaching or suggestion of generating an estimated quantity of content for the content object based on the digital data in the individual content entities selected for the content object and generating a price based on the estimated quantity of content, and selectively utilizing the estimated and actual content counts to generate a price for the content object as recited in the independent claims.

Since the combination of the Yonezawa et al., Okada et al. and Dedrick patents does not disclose, teach or suggest the features recited in independent claims 1, 9 and 17 as discussed above, these claims are considered to be in condition for allowance.

Claims 3 - 6, 10 - 14 and 18 - 22 depend, either directly or indirectly, from independent claims 1, 9 or 17 and, therefore, include all the limitations of their parent claims. The dependent claims are considered to be in condition for allowance for substantially the same reasons discussed above in relation to their parent claims, and for further limitations recited in the dependent claims.

The Examiner has rejected claims 7 - 8, 15 - 16 and 23 - 24 under 35 U.S.C. §103(a) as being unpatentable over the combination of the Yonezawa et al., Okada et al. and Dedrick patents, and further in view of U.S. Patent No. 6,199,054 (Khan et al.).

Briefly, the present invention is directed toward a system, method and data storage device for creating a content object from a group of content entities and calculating the content object cost as described above.

The Examiner takes the position that the combination of the Yonezawa et al., Okada et al. and Dedrick patents discloses the claimed subject matter, except for one of the content entities comprising user provided content. The Examiner further alleges that the Khan et al. patent teaches this feature, and that it would have been obvious to combine the Yonezawa et al., Okada et al., Dedrick and Khan et al. patents to attain the claimed invention.

This rejection is respectfully traversed. Initially, claims 7 - 8, 15 - 16 and 23 - 24 depend, either directly or indirectly, from independent claims 1, 9 or 17 and, therefore include all the limitations of their parent claims. As discussed above, the combination of the Yonezawa et al., Okada et al. and Dedrick patents does not disclose, teach or suggest the features of generating an estimated quantity of content for the content object based on the digital data in the individual digital entities selected for the content object and generating a price based on the estimated quantity of content, and selectively utilizing the estimated and actual content counts to generate a price for the content object as recited in the claims.

The Khan et al. patent does not compensate for the deficiencies of the Yonezawa et al., Okada et al. and Dedrick patents. Rather, the Khan et al. patent discloses a system that monitors
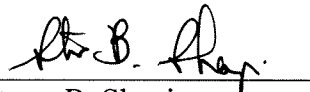
a data payload being transmitted in a secure form over the Internet and provides rate computations for delivery of the payload (similar to postage) and various services (e.g., encryption) (e.g., See Abstract; Column 2, lines 20 - 22). This patent is utilized by the Examiner for an alleged teaching of user provided content subject to price metering. However, the price metering relates to delivery of the payload, as opposed to production of a user-defined content object (e.g., book, album, video, multimedia object, etc.) based on user selected content.

Since the combination of the Yonezawa et al., Okada et al., Dedrick and Khan et al. patents does not disclose, teach or suggest, either alone or in combination, the features recited in claims 7 - 8, 15 - 16 and 23 - 24 as discussed above, these claims are considered to be in condition for allowance.

The application, having been shown to overcome issues raised in the Office Action, is considered to be in condition for allowance and Notice of Allowance is earnestly solicited.

Respectfully submitted,

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